

REMARKS

Claims 1-30, 32-35 and 43-45 were pending in the instant application. Of these, claims 16-30, 32, 34 and 35 had been withdrawn previously by the Examiner. By this Amendment, Applicants have canceled claims 14, 16-30, 32, 34 and 35 without prejudice to future presentation. Applicants have also made appropriate amendments to claims 1, 15, 43, 44, and 45 to remove reference to subject matter that has been withdrawn from consideration. The cancellation of this subject matter is likewise made without prejudice. Applicants have further amended claims 1, 44, and 45 to recite that the double bond in A is at a distance from O which does not appear in a naturally-occurring corresponding radical. Support for this amendment can be found in the specification, *inter alia*, at page 8, lines 7-9. The present Amendment does not introduce any new matter and, thus, its entry is requested. Upon entry of the present Amendment, claims 1-15, 33, and 43-45 will be pending and under examination.

September 29, 2003 Final Office Action

The Examiner acknowledged the Request for Continued Examination filed August 28, 2003, and Applicants' prior election with timely traverse of Group IX and species of compound 372 as set forth in the Restriction Requirement mailed February 25, 2002. The Examiner indicated that the Requirement was deemed final and that subject matter not embraced by elected group IX, and claims 16-30, 32, 34, and 35, were withdrawn from further consideration.

By this Amendment, Applicants have now canceled the non-elected subject matter without prejudice.

Examiner's rejection under 35 U.S.C. §103

In the Final Office Action, the Examiner maintained the rejection of claims 1-15, 33, and 43-45 under 35 U.S.C. §103(a) as allegedly being unpatentable over AT 393505 and Eibl, et al. (EP 534,445), each taken alone. The Examiner has taken the position that the references teach

phosphates, phosphoamines, and phosphate esters which are structurally similar to the instant claimed compounds, asserting that the difference between some of the compounds of the prior art and the claimed compounds “is that the instant claimed compounds are generically described in the prior art.” In particular, the Examiner directed attention to page 9, lines 22-47 and Examples 13 and 14 on page 18 of AT 393505. According to the Examiner, this reference also teaches phosphate esters which are structurally similar to the instant compounds, the specific example compounds differing only from Applicants’ claimed compounds by a methylene group. The Examiner specifically compared Applicants’ claim 1 (wherein p=8 and q=5) and the reference’s Example 14 (p=8 and q=4), stating that one recites a pentyl group (q=5) where the other recites a butyl group (q=4). According to the Examiner, one such homologue does not represent an advance over the other because one of skill in the chemical art, knowing the properties of one homologue, would know what to expect of the other.

In response, without conceding the correctness of the Examiner’s position, but to expedite prosecution of the subject application, Applicants have amended the claims to recite that the double bond in A is at a distance from O which does not appear in a naturally-occurring corresponding radical, i.e., the double bond is not at the same position as it would be in the underlying naturally-occurring alcohol or acid. As set forth throughout the specification, such modifications, achieved through a novel process, allow one to change and specifically control the physical, biochemical, and biological properties of the compounds. Such structural variations in the apolar region lead to compounds exhibiting improved antitumor activity (See page 4, lines 15-24 and page 14, lines 20-32), and further allow one to produce the compounds in industrial quantities. Nothing in the art would motivate one of ordinary skill to undertake such modifications. Therefore, the claims, as amended, are not rendered obvious over the art cited by the Examiner.

The Advisory Actions of April 9, 2004 and May 10, 2004

In an Advisory Action mailed April 9, 2004, the Examiner indicated that Applicants’ March 29, 2004 Amendment would not be entered, because, in the Examiner’s opinion, it would raise new issues requiring further search or consideration and would introduce new matter not supported by

the specification. Following an April 28, 2004 Request for Reconsideration by the Applicants, the Examiner issued a second Advisory Action, dated May 10, 2004, again reiterating the same assertions. Specifically, the Examiner pointed to the introduction of the language into claims 1, 44, and 45, concerning the position of the double bond in Formula A. The Examiner asserted that the specification does not support such an amendment because, in the Examiner's view, the language as used in the specification is directed to the R_1 and R_2 substituents, which occur only in formulas that have been restricted out of the elected invention.

Applicants respectfully disagree with the Examiner's reading of the specification. The specification does in fact support the proposed claim language, even when R_1 and R_2 are absent, as in the currently elected claims. We note, for example, the compounds encompassed by the formula described at page 6, line 12 to page 8, line 3. This formula specifically includes compounds in which A is a radical of the formula VIII, which compounds do not, by definition, include R_1 or R_2 (see page 8, line 3). The next succeeding paragraph refers to structural elements of "the substances described herein," with preference to monounsaturated radicals having the double bond in a non-natural position. Therefore, the specification does not support the Examiner's interpretation that the language concerning the position of the double bond is limited to the R_1 and R_2 substituents. To the contrary, the specification does in fact support claims directed to compounds in which the double bond in the currently recited formula A, in which R_1 and R_2 are absent, is in a non-naturally occurring location. Therefore, contrary to the Examiner's position, the claim amendments set forth in Applicants' unentered March 29, 2004 Amendment, and repeated herein, do not raise new issues that would require further search or consideration and specifically do not introduce any new matter. Applicants further note that the issue of the non-natural position of the double bond was specifically placed before the Examiner in Applicants' June 12, 2002 Response to Restriction Requirement (see, e.g., page 2), thus lending further support to Applicants' position that it was clearly not being raised anew in the March 29, 2004 Amendment. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §103.

In light of the above remarks and amendments, Applicants believe that the Examiner's rejections set forth in the September 29, 2003 Final Office Action and assertions made in the subsequent Advisory Actions dated April 9, 2004 and May 10, 2004, have been fully overcome by the present Amendment and that the present claims fully satisfy the patent statutes. Applicants therefore believe that the application is now in condition for allowance. The Examiner is invited to telephone the undersigned if it is deemed to expedite allowance of the application.

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